

REMARKS

Reconsideration of the present application in light of the above amendments and the following remarks is respectfully requested. Claims 1-7 and 10-16 are pending. No new matter has been added.

**Objection to Priority Claim**

Applicant thanks the Examiner for granting priority under 35 USC § 119(e) to U.S. Provisional Application No. 60/228,956, filed August 28, 2000.

Applicant respectfully traverses the denial of the priority claim of the present continuation-in-part application to U.S. Application No. 08/484,593, now U.S. Patent No. 6,387,650. Specifically, the Action alleges U.S. App. No. 08/484,593, now U.S. Patent No. 6,387,650 ("parent application") does not disclose subject matter "critical" to the currently claimed invention, particularly a conditionally detectable marker that is a red-ox dye, thus rendering the presently claimed invention as allegedly not enabled at the time of filing the parent application.

Applicant traverses this objection and these allegations, and request reconsideration of the priority claim of the present application as a **continuation-in-part** of the parent application, U.S. App. No. 08/484,593, now U.S. Patent No. 6,387,650.

As an initial matter, Applicant disputes the Action's characterization regarding the parent application lacking certain subject matter that is "critical" to the presently claimed invention. In particular, Applicant respectfully disagrees that the phrase "wherein said marker is a red-ox dye" in reference to the "conditionally detectable marker" in unamended claim 1 is "critical" to the presently claimed invention. Applicant notes "conditionally detectable marker" is defined in the present application as "a molecule that undergoes a measurable change (such as a color change) when reacted upon by a viable microorganism in a sample." See lines 25-27, page 8, instant Specification. While red-ox dyes are provided as an example of one type of "conditionally detectable marker" encompassed by the presently claimed invention, it by no means dictates the only such form of a "conditionally detectable marker" included in the claimed

invention. Thus, the phrase “wherein said marker is a red-ox dye” is not “critical” or “essential” subject matter to the presently claimed invention.

Applicant notes that the parent application, U.S. App. No. 08/484,593, is incorporated by reference (as originally filed) in the present application. *See* lines 12-15, page 2, instant Specification. Applicant further notes U.S. Patent No. 4,129,483, which is incorporated by reference in parent application U.S. App. No. 08/484,593, describes using a non-biodegradable substance (tetrazolium), which is chemically reduced to produce a color change. *See* lines 57-59, col. 1, U.S. Patent No. 6,387,650. Thus, the subject matter relating to using a red-ox dye as one form of a “conditionally detectable marker” in the presently claimed invention is fully supported in the parent application, and Applicant’s claim for priority to U.S. App. No. 08/484,593 is proper.

Nonetheless, without acquiescing to the Action’s allegations, but solely to expedite prosecution of the present application, Applicant has amended claim 1 to remove the phrase “red-ox dye.” No new matter has been added by way of this amendment. As noted previously herein, the present application defines “conditionally detectable marker” as “a molecule that undergoes a measurable change (such as a color change) when reacted upon by a viable microorganism in a sample.” *See* lines 25-27, page 8, instant Specification. Furthermore, support for the same may be found in parent application, U.S. App. No. 08/484,593, now U.S. Patent No. 6,387,650 at lines 11-22, col. 4 of the issued patent. (“[D]etectable signal” [means] a characteristic change in a medium or sample that is observable or measurable by physical, chemical, or biological means known to those skilled in the art....[D]etectable signals include a change in color or fluorescent emission of the medium.”). Thus, support for amended claim 1 is found in both the disclosure of the present application, as well as that of the parent application, U.S. App. No. 08/484,593, now U.S. Patent No. 6,387,650.

As an additional matter, Applicant notes the Action contradicts itself in the characterization of both the presently described invention, as well as the content of the parent application. Specifically, while the Action concedes that U.S. App. No. 08/484,593 discloses a composition that comprises a substrate comprising a signal moiety linked to the substrate, wherein the signal moiety can be cleaved to produce a detectable signal, it alleges “[the parent

application] does not teach or suggest inclusion of a conditionally detectable marker that is tetrazolium red, or any redox dye.” See fourth paragraph, page 2, Office Action dated August 8, 2005. The Action then alleges the exact opposite in that WO 96/40980, which claims priority to U.S. App. No. 08/484,593, and contains the same subject matter as the parent application, “teaches examples of detectable markers...such as tetrazolium, phenol red, and neutral red (redox dye), which are chemically reduced to produce a color change...”. See page 4, first paragraph, of the Office Action dated August 8, 2005. Applicant is confused as to how the Action is able to reconcile these contradictory allegations, and respectfully submit the Action fails to provide a basis for objecting to Applicant’s proper priority claim.

Finally, Applicant submits that even assuming *arguendo*, that certain features of particular embodiments of the present invention are not explicitly disclosed in the parent application, the priority claim of the present application as a continuation-in-part to the parent application is still proper. See 37 C.F.R. § 1.53(b)(2): “[a] continuation-in-part application (which may disclose and claim subject matter not disclosed in the prior application)...”.

Therefore, Applicant respectfully submits in light of the amendment and remarks herein, the Action’s objection to the priority claim of the present application to its parent application has been obviated. Accordingly, Applicant respectfully requests this objection be withdrawn and proper priority be granted to the present application as a **continuation-in part** to U.S. App. No. 08/484,593, now U.S. Patent No. 6,387,650, in accordance with 35 U.S.C. § 120, and 37 C.F.R. §1.78.

**Claim Rejection under 35 U.S.C. § 103, First Rejection**

Claims 1-7 and 10-15 stand rejected in accordance with 35 U.S.C. § 103(a) as allegedly being unpatentable over Townsend (WO 96/40980). Specifically, the Action alleges Townsend “teaches examples of detectable markers, such as tetrazolium, phenol red, and neutral red (redox dye), which are chemically reduced to produce a color change and bacterial substrates that change color or fluoresce upon bacterial hydrolysis, or are conditionally detectable markers.” See first paragraph, page 4, Office Action dated August 8, 2005.

Applicant respectfully submits the Action fails to establish a *prima facie* case of obviousness. Furthermore, to the extent priority is now granted, this rejection is moot. Without acquiescing to this ground for rejection, but solely to expedite prosecution of the present application, Applicant has amended claim 1. Applicant respectfully submits the amendment and remarks provided herein are fully responsive to the Action, and obviate this ground for rejection. Accordingly, Applicant respectfully requests this rejection be withdrawn.

**Claim Rejection under 35 U.S.C. § 103, Second Rejection**

Claims 1-7 and 10-16 stand rejected in accordance with 35 U.S.C. § 103(a) as allegedly being unpatentable over Townsend (WO 96/40980) in view of Stern (U.S. Patent No. 5,891,709). Specifically, the Action alleges that while Townsend does not teach the composition further comprising antibiotics, Stern teaches compositions for detecting viable gram negative bacteria comprising antibiotics for suppressing other, non-target microorganisms.

Applicant traverses this ground for rejection and submits the Action fails to provide some suggestion or motivation to combine the cited references, how it is that one of skill in the art would expect a reasonable expectation of success, and where the cited references teach or suggest all of the claim elements that comprise the presently claimed invention. Furthermore, as previously stated herein, Applicant submits the Action asserts contradictory allegations relating to the subject matter taught in Townsend (WO 96/40980).

Nonetheless, without acquiescing to this ground for rejection but solely to expedite prosecution of the present application, Applicant has amended claim 1. Applicant respectfully submits this amendment and these remarks are fully responsive to the Office Action, and this ground for rejection has been overcome. Accordingly, Applicant respectfully requests this rejection be withdrawn.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Application No. 09/940,682  
Reply to Office Action dated August 8, 2005

All of the claims remaining in the application are now clearly allowable.  
Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC



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